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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/373,230	08/12/1999	HARUKI OKMURA	OKAMURA=2E	2359

1444 7590 07/12/2004

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EXAMINER
JIANG, DONG

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/373,230	OKMURA ET AL.	
	Examiner	**Art Unit**	
	Dong Jiang	1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *7-9*.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-6,11 and 14-17*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Lorraine Spector

LORRAINE SPECTOR
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: claims 3-6 and 11 would remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for the recitation of "not substantially altering ... activity" in claims 3 and 11. The term "substantially" is a relative term, and the specification does not define such. As IL-18 has multiple functional activities, it would not be clear to an artisan whether the variants or the fragments of the IL-18 have to remain all activities, or it means changes in degree of some or all activities. The metes and bounds of the claim, therefore, cannot be determined.

Claims 1-6, 11, 14 and 15 would remain rejected under 35 U.S.C. 112, first paragraph, for the reasons of records set forth in the previou Office Actions. Applicants argue, for example, at page 13 of the response, that claim 11 comprises limitations other than "a mAb specif to ...", and the specification discloses that SEQ ID NO:2 has antigenic fragments. Applicants argument has been fully considered, but is not deemed persuasive because the specification does not disclose the specific sequences of the "antigenic fragments". Further, the specification does not disclose that the antigenic fragments of SEQ ID NO:2 have anything to do with the retention of the functional activity.

Claims 1-3, 5, 6, 11, and 14-17 would remain rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura et al. (Infect. Immun. 61: 64-70, 1993), for the reasons of record set forth in the previous Office Actions. Applicants argument has been fully considered, but is not deemed persuasive because Applicants merely argue the ambiguity of the Nakamura reference, and ignore the cited later publications by the same group of investigators, which clearly support that the prior art protein is the same as that of the present invention.

Continuation of 7. see item 5 above.